UNITED STATES PATENT AND TRADEMARK OFFICE

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ANDERSON, FOLASHADE

ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/696,533	COLLE ET AL.
	Examiner	Art Unit	
	FOLASHADE ANDERSON	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *12/23/08*.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-22* is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-22* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a) ☐ All   b) ☐ Some *   c) ☐ None of:
         1. ☐ Certified copies of the priority documents have been received.
         2. ☐ Certified copies of the priority documents have been received in Application No. _____.
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This final office action in response to Applicant's submission filed on December 23, 2008.   Currently, claims 1-22 are pending.   Claims 1, 15 and 21 have been amended.

Response to Amendment

2.   Applicant's amendments to claims 15 and 21 are sufficient to overcome the claims rejection set fourth in the previous office action.

3.   Applicant's amendments to claims 15 and 21 are sufficient to overcome the 35 U.S.C. 112, second paragraph rejection set forth in the previous office action.

Response to Arguments

4.   Applicant's arguments with respect to the 35 U.S.C 101 rejection have been fully considered but they are not persuasive. The claim as amended recites "computer implemented" in the preamble, however this is considered a nominal tie that does not satisfy the requirement of machine or transformation test, wherein a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

5.   Applicant's arguments with respect to the 35 U.S.C. 103(a) have been fully considered but they are not persuasive. Applicant argues (A) with respect to claim 1 Donnelly, Hartlaub nor Hanagan suggest an arrangement in which field human resources can be monitored and scheduled as well as central workshop human resource in order to facilitate the completion of a service action, remarks p.14, and (B) None of the cited references suggest that utilization of human resources can be monitored and if such resource utilization exceeds a certain threshold that the user can be alerted, remarks p.14.

In response to Applicant's argument (A) the Examiner respectfully disagrees. Donnelly teaches "after searching and identifying one or more consultants . . . the resources to fulfill a request, an assignment is made" (figure 3 and col. 12, lines 58-64), and as applicant points out "Donnelly project can include employees in different location and the different location can be identified," remarks p.14. Giving the limitation the broadest reasonable interpretation of the limitation a field resource and central resource simply cannot be the same resource i.e. same person. As Donnelly teaches different employees working in different location it reads on this limitation, here Donnelly teaches in order for the action to be complete the employee (filed resource) must be assigned by a manager (central resource) and the employee (field resource) performs the task (figure 3).

In response to Applicant's argument (B) the Examiner respectfully disagrees and further Examiner notes that this argument is directed toward newly added claim language. As discussed above Donnelly teaches utilization of one or more of the specified field

technician and the specified central workshop technicians. Garry is brought in to teach

the newly recited limitation of an alert is generated to the user when such utilization

exceeds a pre-determined threshold. Garry teaches "[t]he system also alerts managers

as overtime threshold . . . are approached." (p.3, par. 3)

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 21-22 are rejected under 35 U.S.C. 101 because:

In order for a method to be considered a "process" under §101, a claimed process

must either comply with the "machine-or-transformation test" (1) be tied to a particular

machine or apparatus *or* (2) transform a particular article to a different state or thing. *In

re Bilski,* 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008); *Diamond v. Diehr,* 450 U.S.

175, 184 (1981); *Parker v. Flook,* 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson,*

409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method

is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to independent claim 21, the claim language recites the steps of

associating, providing, monitoring, displaying, etc.; however the claim language does

not include the required tie or transformation. Moreover, the claim recites "computer

implemented" in the preamble, however this is considered a nominal tie that does not

satisfy the requirement, wherein a preamble is generally not accorded any patentable

weight where it merely recites the purpose of a process or the intended use of a

structure, and where the body of the claim does not depend on the preamble for

completeness but, instead, the process steps or structural limitations are able to stand

alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*,

187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim 22 is rejected based upon the same rationale, wherein the claim language

does not include the required tie or transformation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-6, 9-12, 14-16, 19 and 20-22 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Donnelly et al (US Patent 6,049,776) in view of Hartlaub (US

Publication 2002/0087116 A1), Hanagan et al (US Publication 2001/0056362 A1) and

Garry (Breaking Barriers, 09/2002).

In regards to claims 1, 15 and 21 Donnelly teaches **a computer system for**

scheduling the performance of service actions that involve activities at multiple

locations, the system comprising:

- **an engine that associates** (col. 2, lines 1-5), **based on user input** (# 100 of figure 3), **resource information for both a first task item to be performed at a field location** (figure 53) **and a second task item to be performed at a central workshop location that is different from the field location** (figure 53), **the first and second task items to be completed as part of a service action** (figure 3; where in order for the action to be complete the employee must be assigned by a manager and the employee performs the task as such the either the manager or the employee is in the filed or the central workshop), **a first portion of the first task item occurring before the second task item and a second portion of the first task item occurring after the second task item** (col. 9 lines 35-37, col. 10, lines 23-25, where the efforts within the task are equivalent to portions) **; and**

- **a repository of resource information associable with the first and second task items** (col. 9, lines 35-37), **the repository including field human resource information** (col. 9, lines 38-40) **so that a specified field technician is associable with the first task item** (col.10, lines 42-45), **central workshop human resource information so that a specified central workshop technician is associable with the second task item** (col.10, lines 42-45), **and work area information for the central workshop location so that a specified work area is associable with the second task item** (col. 10, lines 7-8), **wherein:**

- o **the field human resource information includes availability information for field technicians** (col. 10, lines 23-39 where calendar file contains availability of each human resource)**,**

- o **the central workshop human resource information includes availability information for central workshop technicians** (col. 10, lines 23-39 where calendar file contains availability of each human resource)**, and**

Donnelly teach a technical assistance request that defines an engagement for which human resources are required (col. 7, lines 60-65); however, he does not expressly teach **a selection service with a service order template, the service order template defining, the work area information includes availability information for central workshop locations, and an alert is generated to the user when such utilization exceeds a pre-determined threshold**.

Hanagan teaches **a selection service with a service order template, the service order template defining** (0262)

It is old and well known in the art of scheduling that it is protocol to check the availability of a location prior to assign a task to it as evident by Hartlaub (par. 0057) in the scheduling of appoints in the analogous art of patient appointment scheduling.

It would have been obvious to one of ordinary skill in the art to include the teachings of Hartlaub, room availability, and the Donnelly in the invention of Donnelly to alleviate the manual task of scheduling service request (Hanagan 0277) and allow for a

scheduling routine that the system automatically implements and verifies (Hartlaub 0020).

Garry teaches **an alert is generated to the user when such utilization exceeds a pre-determined threshold** (p.3, par. 3)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Donnelly, Hanagan, and Hartlaub the alerting feature as taught by Garry since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As a point of clarification Donnelly does not expressly teach a "first" and "second" or a "field" and "central workshop" worker. Donnelly teaches a human resource (col. 2, lines 46-48) and he also teaches the user (human resource) can be remote (col. 8, lines 41-42). The Examiner interprets the invention to be capable of use by both works located internally (central workshop) as well as in the field. As such the claimed invention of the instant application is used for assigning field and central worker, one of ordinary skill in the art at the time the invention was made could have used the invention of Donnelly to implement a predictable variation resulting in essentially the same types of assignments, see KSR International Co v. Teleflex Inc, 550 U.S. __, 82 USPQ2d 1385 (2007).

Further in regards to claims 15 and 21 which are the medium and method respectively for interacting with the system of claim 1. These claims are implied and

depend upon the system of claim 1 and therefore are rejected for substantially the same reason given above with respect to claim 1.

In regards to claim 21 which recites the additional limitations of Donnelly teaches **providing information characterizing the associating to the user via the graphical user interface** (col.7, lines 43 and 54-55) **and** Garry teaches **displaying an alert to the user when the utilization of the one or more of the specified field technician can the specified central workshop technician exceeds a pre-determined threshold** (p.3, par.2 where web-base software implies a graphical user interface for the displaying of the alert disclosed p.3, par. 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Donnelly, Hanagan, and Hartlaub the alerting feature as taught by Garry since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In regards to claims 2, 16, and 22 Donnelly teaches:

- **the first task item includes a field human resource skill requirement** (col. 26, lines 40-45),

- **the second task item includes a central workshop human resource skill requirement** (col. 26, lines 40-45),

- **the field human resource information includes an indication of a skill possessed by particular field technicians** (col. 10, lines 9-18),

- **the central workshop human resource information includes an indication of a skill possessed by particular central workshop technicians** (col. 10, lines 9-18),

- **the engine associates the specified field technician with the first task item only when the indication of the skill possessed by the specified field technician matches the field human resource skill requirement of the first task item** (col. 29, lines 9-22), **and**

- **the engine associates the specified central workshop technician with the second task item only when the indication of the skill possessed by the specified central workshop technician matches the central workshop human resource skill requirement of the second task item** (col. 29, lines 9-22).

As a point of clarification Donnelly does not expressly teach a "field" or "central workshop" worker. Donnelly teaches a human resource (col. 2, lines 46-48) and he also teaches the user (human resource) can be remote (col. 8, lines 41-42). Additionally Donnelly teaches that skill sets are known per employee (col. 10, line 9-10). The Examiner interprets the invention to be capable of use by both works located internally (central workshop) as well as in the field. As such the claimed invention of the instant application is used for assigning field and central worker, one of ordinary skill in the art at the time the invention was made could have used the invention of Donnelly to implement a predictable variation resulting in essentially the same types of

assignments, see KSR International Co v. Teleflex Inc, 550 U.S. __, 82 USPQ2d 1385 (2007).

Further in regards to claims 16 and 22 which are the medium and method respectively for interacting with the system of claim 2. These claims are implied and depend upon the system of claim 2 and therefore are rejected for substantially the same reason given above with respect to claim 2.

In regards to claims 3-5 Donnelly teaches **the availability information is provided to the repository of resource information from a computer system other than the computer system for scheduling the performance of service actions** (col. 9, lines 31-34).

Donnelly does not expressly teach that the specific data recited in claims **the availability information** is **for field (central) technicians (or workshop location)**; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.*

In regards to claim 6 Donnelly teaches **wherein the engine is configured to send the first task item for the service action to a mobile client** (col. 8, lines 8-46).

In regards to claims 9-11, 9 and 20 Donnelly teaches **wherein the engine is configured to receive, from a mobile client** (col. 8, lines 41-46), **user input that specifies the specified** employee **to be associated with the task item** (col. 12, lines 63-67).

Donnelly does not expressly teach that the specific data recited in claims that the employee is a **field (central workshop) technician (or work area) to be associated with the first (second) task item** however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ₰ 2106.*

Further in regards to claims 19 and 20 which refer to the medium for interacting with the system of claims 9 and 10 respectively. These claims are implied and depend upon the system of claims 9 and 10 and therefore are rejected for substantially the same reason given above with respect to claims 9 and 10.

In regards to claim 12 Donnelly teaches **wherein the engine is configured to receive, from a mobile client** (col. 8, lines 41-46).

Donnelly and Hartlaub are silent on **user input that specifies an amount of time spent on the first task item or an amount of time spent on the second task item.**

Official notice is taken that is was an old and well know practice in the art at the time the invention was made that an employee would convey to his employer or the customer the amount of time spent on a task.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the old and well known practice of reporting time spent on a task in the in the invention of Donnelly to provide the system with an update on the employees availability.

In regards to claim 14 Donnelly teaches **wherein the engine is configured to receive, from a mobile client** (col. 8, lines 41-46).

Donnelly and Hartlaub are silent on **user input that specifies whether the first task item is completed or specifies whether the second task item is completed.**

Official notice is taken that is was an old and well know practice in the art at the time the invention was made that an employee would convey to his employer or the customer that a task was completed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the old and well known practice of reporting task completion in the in the invention of Donnelly to provide the system with an update on the employees availability.

9.   Claims 7, 8, 13, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donnelly et al (US Patent 6,049,776) and Hartlaub (US Publication 2002/0087116 A1) as applied to claims 1 and 15 above and in further view of ServicePower.com (www.archive.org/www.servicepower.com, published 11/11/2001).

In regards to claims 7, 8, 17 and 18 Donnelly teaches that once an employee's assignment has been updated the employee is sent notification of the schedule changes (col. 29, lines 18-22).

Donnelly and Hurtlaub are silent on **wherein the engine is configured to send the first (second) task item for the service action to a mobile client.**

Official notice is taken that it was old and well known in the art at the time the invention was made that mobile communication was available for task assignment as evidenced by ServicePower (pg. 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the old and well known technology of mobile commutations in the invention of Donnelly to support trends in innovations (ServicePower pg. 24).

Additionally the Examiner notes that neither Donnelly nor Service power explicitly teaches a **first (second) task item for the service action** is sent; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention

from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217*

USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed.

Cir. 1994); MPEP ∂ 2106.

Further in regards to claims 17 and 18 which refer to the medium for interacting

with the system of claims 7 and 8 respectively. These claims are implied and depend

upon the system of claims 7 and 8 and therefore are rejected for substantially the same

reason given above with respect to claims 7 and 8.

In regards to claim 13 Donnelly teaches **wherein the engine is configured to**

receive, from a mobile client (col. 8, lines 41-46).

Donnelly and Hartlaub are silent on **user input that specifies a spare part**

used in performing the first task item or a spare part used in performing the

second task item (ServicePower, pg. 8)

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the teachings of ServicePower in the invention of Donnelly

to accurately account for spare parts to be bill the customer.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Garcia et al (2004/0093256) teaches alert display when an

overtime threshold is reached.

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action.   Accordingly, **THIS ACTION IS MADE FINAL.**   See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to FOLASHADE ANDERSON whose telephone number is

(571)270-3331. The examiner can normally be reached on Monday through Thursday

8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623